

REMARKS

In the Office Action, the Examiner took the following actions:

- (1) rejected claim 26 under 35 U.S.C. § 101 as directed to non-statutory subject matter;
- (2) rejected claims 1-26 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 and 6-12 of co-pending U.S. Patent Application No. 10/720,920 (the "920 application");
- (3) rejected claims 1-26 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-37 and 110 of co-pending U.S. Patent Application No. 10/858,973 (the "973 application");
- (4) rejected claims 1-14 and 19-26 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement;
- (5) rejected claims 1-14, and 19-26 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention;
- (6) rejected claims 1-14, 19-21, and 23-26 under 35 U.S.C. § 102(e) as being clearly anticipated by U.S. Patent No. 6,459,913 to Cloutier et al. ("Cloutier"); and
- (7) rejected claim 22 under 35 U.S.C. § 103(a) as being unpatentable over Cloutier in view of U.S. Patent No. 5,661,788 to Chin ("Chin").

By this Reply, Applicants have amended claims 1, 12, 19, and 26. Support for the amendments can be found in the specification, for example, at page 32, lines 11-19. Claims 15-18 were previously canceled without prejudice or disclaimer. Claims 1-14 and 19-26 are pending, with claims 1, 12, 19, and 26 being independent. Based on the

foregoing amendments and the following remarks, Applicants respectfully request reconsideration and withdrawal of the rejections of the pending claims.¹

I. The § 101 Rejection of Claim 26

The Examiner rejected independent claim 26 “under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.” Office Action at 2. The Examiner asserted that “[s]ince ‘medium’ is not defined in the disclosure, it may encompass a variety of media ranging from a piece of paper to a carrier signal.” Office Action at 3. The Examiner also asserted that “comprising is not an acceptable linking word to associate ‘computer readable medium’ to a ‘computer program product.’” Id. Although Applicants disagree with the Examiner’s assertions, in order to advance prosecution, Applicants have amended independent claim 26 to recite “[a] non-transitive computer-readable medium encoded with instructions.” Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 101 rejection of claim 26.

II. The Nonstatutory Obviousness-type Double Patenting Rejections

The Examiner rejected claims 1-26 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 and 6-12 of co-pending ‘920 application, and rejected claims 1-26 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-37 and 110 of co-pending

¹ As Applicants’ remarks with respect to the Examiner’s rejections are sufficient to overcome these rejections, Applicants’ silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., whether a reference constitutes prior art, ability to combine references, assertions as to patentability of dependent claims) is not a concession by Applicants that such assertions are accurate or such requirements have been met, and Applicants reserve the right to analyze and dispute such in the future.

973 application. Id. Applicants respectfully traverse the nonstatutory obviousness-type double patenting rejections of claim 1-21 for the following reasons.

The Examiner alleged that “claim 1 of the pending application [is] the same as claim 1 of the co-pending [‘920] application except receiving a notification at a server.” Office Action at 3. This is incorrect. Even assuming the Examiner’s allegation was correct, which Applicants do not concede, the Examiner’s position does not appear to take account of amendments presented in both this application and the ‘920 application.

Similarly, the Examiner alleged that “claim 1 of the pending application [is] the same as claim 1 of the co-pending [‘973] application except [for the] displaying step.” Office Action at 3. Again, this statement is incorrect, and the Examiner does not appear to have taken account of amendments presented in both this application and the ‘973 application.

M.P.E.P. § 707.07(f) states, “[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant’s argument and answer the substance of it” (emphasis added). However, the Examiner failed to respond to Applicants’ numerous traversals of the double patenting rejections. See Amendments filed September 4, 2008, at 8-9; Amendment filed January 23, 2009 at 8-9; Amendment filed July 6, 2009 at 9-10; and Pre-Appeal Brief Request for Review filed December 17, 2009 at 1-3.

Instead, the double patenting rejection remains identical to the double patenting rejection originally asserted on pages 2-3 of the Office Action mailed June 4, 2008. Moreover, Applicants have amended the claims of this application three times, in each case also traversing the double patenting rejection. See Amendments filed

September 4, 2008, January 23, 2009, and July 6, 2009. In each case, the Examiner has maintained the double patenting rejections, stating that "claim 1 of the pending application [is] the same as claim 1 of the co-pending ['920] application except receiving a notification at a server" and "claim 1 of the pending application [is] the same as claim 1 of the co-pending ['973] application except displaying step." See Office Action mailed June 4, 2008 at 2-3; Final Office Action mailed December 22, 2008 at 2-3; Office Action mailed April 15, 2009 at 2-3; Final Office Action mailed November 13, 2009 at 3-4; and Office Action mailed June 22, 2010 at 3-4.

Moreover, as Applicants have previously pointed out, any double patenting rejection over the claims of co-pending applications should be a provisional double patenting rejection. See Amendments filed September 4, 2008 at pages 8-9 including footnote 2; Amendment filed January 23, 2009, pages 8-9; Amendment filed July 6, 2009; and Pre-Appeal Brief Request for Review filed December 17, 2009.

Applicants respectfully submit that, in light of Applicants' repeated traversals of the double patenting rejections, numerous amendments filed in this application, the '920 application, and the '973 application, and the clear deficiencies of the merits of the double patenting rejections, the Office Action does not comply with MPEP § 707.07(f). The Examiner has not "answer[ed] the substance" of Applicants' numerous traversals of the rejections. For at least these reasons, Applicants respectfully request reconsideration and withdrawal of the double patenting rejections.

III. The § 112, First Paragraph, Rejection of Claims 1-14 and 19-26

The Examiner rejected claims 1-14 and 19-26 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Office Action at 5. The Examiner asserted that "[r]egarding claim 1, the limitation 'receiving incoming call data' and 'converting the incoming call data' were not disclosed in the original specification." Id. The Examiner further asserted that "[t]he original specification states 'receiving incoming notification' and 'converting the incoming notification.'" Id.

A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. M.P.E.P. § 2163.04 (citing *In re Marzocchi*, 439 F.2d 220, 224 (CCPA 1971)). The Examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. Id.

Applicants submit that the Examiner has failed to establish a *prima facie* case of inadequate written description and failed to provide any reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. The limitation 'receiving incoming call data' is supported by the original specification. For example, the specification, at least on page 38, lines 9-16, provides that:

... A switch (such as SSP 310, Figure 5) detects and receives a call placed by a calling party 120 to user phone 114 and forwards the call to network access server 410 (step 810). A call may be detected by configuring SSP 310 to trigger an alert to be sent to ISCP 302 whenever a call is placed to a user's phone.

After network access servers 410 receives the call (step 810),

network access servers 410 may forward caller ID information from the call to digital companion server 406 (step 820).

In addition, the specification, on page 39, lines 8-12, also provides that:

Back end servers 420 receive voice mail and caller ID information from the calling party over the voice network 508 and forward the voice mail and caller ID information to the digital companion server 406 (step 920).

Similarly, with respect to the limitation 'converting the incoming call data,'

Applicants submit that a person skilled in the art at the time the application was filed would have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. In order advance prosecution, however, Applicants have amended independent claim 1 to recite "generating a notification of the incoming call from the incoming call data, wherein the notification is converted into a data format for the preferred device." Amended independent claims 12, 19, and 26, although of different scope, recite elements that are similar to those recited in amended independent claim 1. Therefore, the § 112, first paragraph, rejection of amended independent claims 1, 12, 19, and 26 should be withdrawn.

The Examiner did not specifically allege inadequate written description with respect to the dependent claims, and the dependent claims were rejected under 35 U.S.C. § 112, first paragraph, merely for depending from independent claim 1, 12, or 19. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the § 112, first paragraph, rejection of claims 1-14 and 19-26.

IV. The § 112, Second Paragraph, Rejection of Claims 1-14 and 19-26

The Examiner rejected claims 1-14 and 19-26 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the

subject matter which applicant regards as the invention. Office Action at 5. The Examiner asserted that "Claim 1 recites the limitation 'the data format' in line 9 of the call[, and t]here is insufficient antecedent basis for this limitation in the claim." Id. Applicants have amended independent claims 1, 12, 19, and 26 to provide sufficient antecedent basis.

The Examiner did not specifically allege indefiniteness with respect to the dependent claims, and the dependent claims were rejected under 35 U.S.C. § 112, second paragraph, merely for depending from independent claim 1, 12, or 19. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the § 112, second paragraph, rejection of claims 1-14 and 19-26.

V. The § 102(e) Rejection of Claims 1-14, 19-21, and 23-26

The Examiner rejected claims 1-14, 19-21, and 23-26 under 35 U.S.C. § 102(e) as being clearly anticipated by Cloutier. Applicants traverse the § 102(b) rejection of claims 1-14, 19-21, and 23-26 because Cloutier does not disclose each and every element recited in claims 1-14, 19-21, and 23-26.

For example, amended independent claim 1 recites, among other things, "determining whether the preferred device is available to receive the notification without transmitting the notification to the preferred device." Cloutier does not disclose at least this element of amended independent claim 1.

Instead, Cloutier determines whether a subscriber is reachable by attempting to alert the subscriber via the highest priority devices and if unsuccessful, then the next highest priority device(s). Cloutier, col. 8, lines 55-60; FIG. 9, step 1008. "The controller 402 determines that the subscriber is not reachable only when all of the

identified device and alert command has been exhausted." Cloutier, col. 8, lines 61-63. Because Cloutier discloses determining whether a subscriber is reachable by alerting the device, Cloutier fails to disclose "determining whether the preferred device is available to receive the notification without transmitting the notification to the preferred device," as recited in amended independent claim 1.

For at least these reasons, Cloutier fails to disclose each and every element recited in amended independent claim 1. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 102(e) rejection of independent claim 1 based on Cloutier.

Amended independent claims 12, 19, and 26, although of different scope, recite elements that are similar to those recited in amended independent claim 1. For at least reasons similar to those reasons set forth above with respect to amended independent claim 1, Cloutier fails to disclose each and every element recited in amended independent claims 12, 19, and 26. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 102(e) rejection of claims 12, 19, and 26 based on Cloutier.

Dependent claims 2-11 and 23-25 depend from amended independent claim 1, dependent claims 13 and 14 depend from amended independent claim 12, and dependent claims 20 and 21 depend from amended independent claim 19. Therefore, dependent claims 2-11, 13, 14, 20, 21, and 23-25 incorporate elements that are missing from Cloutier as explained above, and are allowable at least for similar reasons. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 102(e) rejection of claims 2-11, 13, 14, 20, 21, and 23-25 based on Cloutier.

VI. The § 103(a) Rejection of Claim 22 Based on Cloutier and Chin

Claim 22 depends from amended independent claim 1. As explained above with respect to amended independent claim 1, Cloutier fails to disclose at least "determining whether the preferred device is available to receive the notification without transmitting the notification to the preferred device," as recited in amended independent claim 1.

Chin is directed to a "method and telephone system for selectively answering incoming telephone calls by enabling user selection of a receiving mode that designates telephone numbers and an alert mode that designates how the user will be notified of incoming calls from the designated telephone numbers, and then establishing an idle state." Chin, Abstract. Chin does not teach or suggest "determining whether the preferred device is available to receive the notification without transmitting the notification to the preferred device," as recited in amended independent claim 1, and the Office Action does not dispute otherwise as Chin is relied upon only for its alleged teachings of other elements recited in the dependent claim. Office Action at 10. Therefore, and without conceding any assertions with respect to Chin, Chin fails to cure the deficiencies of Cloutier.

For at least above reasons, the Office Action has failed to clearly articulate a reason why claim 22 would have been obvious to one of ordinary skill in the art in view of the prior art. Accordingly, a *prima facie* case of obviousness has not been established with respect to claim 22, and the rejection under 35 U.S.C. § 103(a) should be withdrawn.

VII. Conclusion

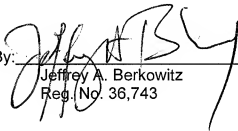
In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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